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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.   |
|--|-------------|----------------------|---------------------|--------------------|
| 10/666,707   | 09/19/2003  | Ralph de la Torre    | MED-019             | 1994               |
| 36822  | 7590        | 07/14/2006           | EXAMINER            |                    |
| GORDON & JACOBSON, P.C.<br>60 LONG RIDGE ROAD<br>SUITE 407<br>STAMFORD, CT 06902 |             |                      |                     | REIMERS, ANNETTE R |
|  |             | ART UNIT             |                     | PAPER NUMBER       |
|  |             | 3733                 |                     |                    |

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/666,707             | DE LA TORRE ET AL.  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Annette R. Reimers     | 3733                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5-8 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-16,18 and 19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-8,10,11,17,20 and 21 is/are rejected.
- 7) Claim(s) 12 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, 10-11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cragg (US Patent Number 6,315,789).

Cragg discloses various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, 14, having a first end, 22, and a second end, 24, wherein the first end of the swivel has a non-circular, i.e. elongate, keyway for engaging a key on a deployment tool (see figure 1). In addition, the first end has a reduced diameter portion, 34, adjacent to the first end (see figure 1).

A first length of string extends from the first end of the swivel and a second length of string extends from a point substantially midway between the first end and the second end, wherein the visually distinguishable first and second lengths of string having sufficient length such that either may be pulled from outside the body cavity, such that pulling on the second length of string is capable of causing the swivel to swivel off of the key on the deployment tool and be oriented substantially perpendicular to the second length of string, and pulling on the first length of string causes the swivel to be oriented substantially coaxial to the first length of string (see figures 1-6 and 9).

The swivel is substantially cylindrical with a curved first end and the second end being substantially conical (see figure 1). The swivel has a surface groove, 38, extending substantially from the first end to the point substantially midway between the first end and the second end, and the surface groove having a depth sufficient to receive the second string (see figures 1-2).

The swivel has an outer surface, an axial bore extending from the first end to the point substantially midway between the first end and the second end, and a radial bore extending from the axial bore to the surface at the point substantially midway between the first end and the second end (see figures 1-2). The first and second lengths of string can part of a single length of string passing through the axial and radial bores (see figures 5-6 and 8-9). The first and second lengths of string are joined together where the axial bore intersects the radial bore (see figure 1-4).

The surgical retractor device of Cragg further comprises a hollow tube, 18, having a proximal end and a distal end, the first end of the swivel being removably mounted in the distal end of the tube; and a hollow pushrod, e.g. 70, having a proximal end and a distal end, the pushrod extending through the hollow tube with the distal end of the pushrod facing the first end of the swivel (see figures 1-2 and 5). Regarding claim 20, it is apparent that the first length of string and the second length of string are visually distinguishable (emphasis added) (see figures 1-3).

With regard to the statement of intended use and other functional statements, e.g. "for engaging a key on a deployment tool" and "pulling on said second length of string causes said swivel to swivel off the key on the deployment tool," they do not

impose any structural limitations on the claims distinguishable over Cragg, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 1-2, 6-8, 10, 11, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerier et al. (US Patent Number 5,100,417).

Cerier et al. disclose various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, 92, having a first end and a second end, wherein the first end of the swivel has a non-circular, i.e. elongate, keyway, 40 and 42, for engaging a deployment tool (see figures 3 and 8). A first length of string extends from the first end of the swivel and a second length of string extends from a point substantially midway between the first end and the second end, wherein the visually distinguishable first and second lengths of string having sufficient length such that either is capable of being pulled from outside the body cavity, such that pulling on the second length of string is capable of causing the swivel to swivel off of the key on the deployment tool and be oriented substantially perpendicular to the second length of string, and pulling on the first length of string would cause the swivel to be oriented

substantially coaxial to the first length of string (see figures 1 and 9). The swivel is substantially cylindrical with a curved first end and the second end being substantially conical (see figures 3 and 8).

The swivel has an outer surface, an axial bore extending from the first end to the point substantially midway between the first end and the second end, and a radial bore extending from the axial bore to the surface at the point substantially midway between the first end and the second end (see figures 1-3 and 8-9). The first and second lengths of string are can be part of a single length of string passing through the axial and radial bores (see figures 8-9). The first and second lengths of string are joined together where the axial bore intersects the radial bore (see figures 8-9). The surgical retractor device of Cerier et al. further comprises a hollow tube, e.g. 12, having a proximal end and a distal end, the first end of the swivel being removably mounted in the distal end of the tube; and a pushrod, e.g. 22, having a proximal end and a distal end, the pushrod extending through the hollow tube with the distal end of the pushrod facing the first end of the swivel (see figure 2). Furthermore, the distal end of the pushrod has a key, 36, which engages the keyway (see figures 2-3). Regarding claim 20, it is apparent that the first length of string and the second length of string are visually distinguishable (emphasis added) (see figures 1-2 and 8).

With regard to the statement of intended use and other functional statements, e.g. "for engaging a key on a deployment tool" and "pulling on said second length of string causes said swivel to swivel off the key on the deployment tool," they do not impose any structural limitations on the claims distinguishable over Cerier et al., which

is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 6-8, 10-11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cope (US Patent Number 6,110,183).

Cope discloses various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, 30, having a first end, 32 and a second end, 34, wherein the first end of the swivel has a keyway for engaging a key on a deployment tool (see figures 1 and 4-6) A first length of string extends from the first end of the swivel and a second length of string extends from a point substantially midway between the first end and the second end, wherein the visually distinguishable first and second lengths of string having sufficient length such that either may be pulled from outside the

body cavity, such that pulling on the second length of string is capable of causing the swivel to swivel off of the key on the deployment tool and be oriented substantially perpendicular to the second length of string, and pulling on the first length of string to be oriented substantially coaxial to the first length of string (see figures 13-17). The swivel is substantially cylindrical with a curved first end and the second end being substantially conical (see figures 4-6). The swivel has a surface groove, 183, extending substantially from the first end to the point substantially midway between the first end and the second end, the surface groove having a depth sufficient to receive the second string (see figures 20-21).

The swivel has an outer surface, an axial bore extending from the first end to the point substantially midway between the first end and the second end, and a radial bore extending from the axial bore to the surface at the point substantially midway between the first end and the second end (see figures 4-6 and 20-21). The first and second lengths of string are capable of being part of a single length of string passing through the axial and radial bores (see figures 4-6). The first and second lengths of string are joined together where the axial bore intersects the radial bore (see figure 7).

The surgical retractor device of Cope further comprises a hollow tube, 10, having a proximal end and a distal end, the first end of the swivel being removably mounted in the distal end of the tube; and a pushrod, 20, having a proximal end and a distal end, the pushrod extending through the hollow tube with the distal end of the pushrod facing the first end of the swivel (see figures 3 and 8). Regarding claim 20, it is apparent that

the first length of string and the second length of string are visually distinguishable (emphasis added) (see figures 7 and 12-17).

Cope discloses the claimed invention except the swivel having a non-circular keyway. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct a non-circular keyway on the swivel of Cope, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a keyway for engaging a key. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cope (US Patent Number 6,110,183) in view of Pedlick et al. (US Patent Number 5,961,538).

Cope discloses the claimed invention except for the first length of string and the second length of string being different colors. Pedlick et al. discloses a surgical retractor device comprising sutures of different colors and teaches "the sutures being identifiable by color such that the suture can be distinguished from other sutures of other colors" (see column 5, lines 41-43). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Cope with the first length of string and the second length of string being different colors, in view of Pedlick et al., in order to identify/distinguish the first length of string from the second length of string.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cragg (US Patent Number 6,315,789) in view of Pedlick et al. (US Patent Number 5,961,538).

Cragg discloses the claimed invention except for the first length of string and the second length of string being different colors. Pedlick et al. discloses a surgical retractor device comprising sutures of different colors and teaches "the sutures being identifiable by color such that the suture can be distinguished from other sutures of other colors" (see column 5, lines 41-43). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Cragg with the first length of string and the second length of string being different colors, in view of Pedlick et al., in order to identify/distinguish the first length of string from the second length of string.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cerier et al. (US Patent Number 5,100,417) in view of Pedlick et al. (US Patent Number 5,961,538).

Cerier et al. disclose the claimed invention except for the first length of string and the second length of string being different colors. Pedlick et al. discloses a surgical retractor device comprising sutures of different colors and teaches "the sutures being identifiable by color such that the suture can be distinguished from other sutures of other colors" (see column 5, lines 41-43). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Cerier et al. with the first length of string and the second length of string being different colors, in view of Pedlick et al., in order to identify/distinguish the first length of string from the second length of string.

***Allowable Subject Matter***

Claim 12 is objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed on April 28, 2006 have been fully considered, but they are not persuasive. First, regarding "the Examiner must give the claim language the meaning that is provided by the applicant's specification and not the broadest reasonable interpretation," applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (emphasis added) See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the Cope reference, examiner respectfully disagrees with applicant, since Cope discloses the structural limitations, e.g. an elongate swivel, 30, with a keyway and a pushrod, 20, claimed by applicant (see explanations above). Regarding claim 20, it is apparent that the first length of string and the second length of string are visually distinguishable (emphasis added) (see figures 7 and 12-17)

Regarding the Cragg reference, examiner respectfully disagrees with applicant, since Cragg discloses the structural limitations, e.g. an elongate swivel, 14, with an elongate keyway. Regarding claim 20, it is apparent that the first length of string and the second length of string are visually distinguishable (emphasis added) (see figures 1-3)

Regarding the Cerier et al. reference, examiner respectfully disagrees with applicant, since Cerier et al. disclose the structural limitations, e.g. an elongate swivel, 92, with an elongate keyway. Regarding claim 20, it is apparent that the first length of string and the second length of string are visually distinguishable (emphasis added) (see figures 1-2 and 8)

It appears as though applicant is arguing the Cragg and Cerier et al. references as non-analogous art. However, the non-analogous art argument is only proper for a 103(a) rejection not for a 102(b) rejection, as these references have been presented above by examiner.

Examiner maintains that the devices disclosed by Cope, Cragg and Cerier et al. include the structural limitations claimed by applicant, including a elongate swivel with a keyway for engaging a key on a deployment tool, wherein pulling on the second length of string causes the swivel to swivel off the key on the deployment tool. It is therefore the burden of the applicant to provide enough information to prove that the structure disclosed in Cope, Cragg and Cerier et al. is not capable of performing the claimed function(s).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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